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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,869	09/21/2000	Thomas Vaughn Wilder	DAREDEV.018RA	4598
20995 7590 03/04/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER BOTTORFF, CHRISTOPHER				
ART UNIT 3618		PAPER NUMBER		
NOTIFICATION DATE 03/04/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

09/669,869

Applicant(s)

WILDER ET AL.

Examiner

Christopher Bottorff

Art Unit

3618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13 and 16-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

The amendment filed February 26, 2007 has been entered.

Claim Rejections - 35 USC § 251

Claims 13 and 16-53 are rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See the 3rd and 4th paragraphs of 35 USC 251 and Section 1401 of the MPEP.

Note that an Amendment dated 3-19-1997 and an Examiner's Amendment dated 03-31-1998 in patent application 08/682,808, that was agreed to by applicant's representative, Jonathan A. Barney, added the following quoted limitations to claim 1 to overcome the prior art:

A) "integrally formed" roller skate chassis

B) "laterally spaced longitudinal members"

C) "generally planar upper portions with upper edges integrally attached.. said heel and forefoot attachment members"

D) one of said upper portions being "substantially coplanar with a respective lower portion, the other one of said upper portions being" inclined toward the coplanar one of said upper portions

E) "and integrally attached to said longitudinal members where said upper and lower portions intersect"

Note that the above Amendment also added the following quoted limitations to claim 5:

- a) "An integrally formed" roller skate chassis
- b) "laterally spaced" longitudinal members "having upper edges integrally" attached to said heel and forefoot members... longitudinal members having upper and lower "generally planar portions"
- c) "separated by one or more web members extending between said longitudinal members and attached thereto"
- d) convergent planes "in an upwardly extending direction above said one or more web members"

All these above limitations need to be present in the new claims (13 and 16-53).

Response to Arguments

Oath/Declaration

Applicant's arguments filed February 26, 2007 with respect to the statement of error in the declaration have been fully considered. As noted in the office action of August 2, 2005, the statement of error in the declaration filed April 30, 2001 is not correct. Although paragraph 6 of this declaration presents numerous limitations from

patented claim 5 and reissue claim 13, the declaration does not establish how the features of the patented claim are “unnecessary to practice the invention” and are “irrelevant to allowance” such that they may present an error as stated in paragraph 5 of the declaration.

For example, the requirement of patented claim 5 that the upper portions form substantially convergent planes in an upwardly extending direction above the one or more web members, as discussed on page 15 of the remarks filed 2/26/2007, is discussed in the original disclosure as being an important feature of the invention and was added by amendment to obtain allowance. This claimed feature is necessary to practice the invention and was relevant to allowance, contrary to the statement of error. Also, the direct comparison of this limitation with a corresponding limitation in reissue claim 13 is not presented in the declaration as it was in the 2/26/2007 remarks, which undermines the clarity of the declaration statement of error and requires the reader to search for the alleged error.

However, the statement of error presented in paragraph 5 of the supplemental declaration filed August 4, 2003 is sufficient to satisfy this reissue declaration requirement. The error stated was that the patented claims lacked a claim directed to a method of making a roller skate chassis. The addition of the method claims to this reissue application corrects this error. Accordingly, the previous rejection of the claims due to a defective declaration has been withdrawn.

Recapture

Applicants' amendment and arguments, regarding recapture as it applies to the requirements of patented claim 5, have been fully considered and are persuasive with regard to the apparatus claims. Applicants' amendment and remarks address sections "a" through "d" and "A" through "C" of the rejection with regard to the apparatus claims. However, Applicants' recapture analysis focused on patented claim 5 and did not address patented claim 1. The subject matter of claim 1 surrendered in the application for the patent upon which the present reissue is based must also be addressed such that the reissue claims avoid recapture of this subject matter. Sections "A" through "C" of the rejection, pertaining to claim 1, were addressed due to the similarity to the limitations identified in sections "A" through "C" with limitations in claim 5. However, the limitations identified in sections "D" and "E" of the rejection, pertaining to claim 1, are not present in all of the claims. The claims must be amended to include these limitations.

In regard to method claims 29-35 and 46-53, the arguments have been fully considered but they are not persuasive. The remarks assert that the recapture rule does not apply to method claims since they are a different class of claims. M.P.E.P. § 1412.02 (II) and (III) is cited in support of this assertion. However, the introduction of method claims in a reissue when only apparatus claims were presented in the prosecution of the original patent does not necessarily avoid recapture. When, as here, the method claims are so constructed that they mimic the apparatus claims by reciting the same structure in terms of the acts of the structure's construction, without notable distinction, the recapture rule applies. In this case, claims 29-35 and 46-53 are not patentably distinct from the apparatus claims even though presented as method claims.

Moreover, the mere introduction of method claims in a reissue where only apparatus claims were presented in the prosecution of the original patent avoids the recapture rule when the method claims qualify for treatment under 35 U.S.C. § 103(b). See M.P.E.P. § 1412.02 (II). To qualify for treatment under 35 U.S.C. § 103(b), the claims must relate to biotechnology. See 35 U.S.C. § 103(b). The present invention involves a roller skate chassis, not biotechnology. Thus, the presence of method claims 29-35 and 46-53 does not automatically avoid recapture. Method claims 29-35 and 46-53 must also avoid recapturing the limitations identified in the rejection above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Bottorff
/Christopher Bottorff/
Primary Examiner, Art Unit 3618